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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,137	06/25/2003	David Vincent Zyzak	9043MXL	3971

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,137

Applicant(s)

ZYZAK ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 22, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

i) Claims 11-32 and 45-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the claims to generally read "... wherein the level of acrylamide [or asparagine] in said food material is reduced by at least about 10% from the level in the food material in a previous condition." The phrase "from the level in the food material in a previous condition" has been added; however, applicant has not pointed out where in the specification this phrase actually finds support. This is not apparent from the specification, and furthermore, the phrase appears to broaden the scope of the original description and claims. Applicant is required to present evidence of support for this phrase, or cancel the improperly added subject matter.

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ii) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-32 and 45-50 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As previously addressed on the record, the term "reduced", in the product/article claims, is a relative term which renders the claims indefinite. The term "reduced" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicant's arguments filed August 22, 2005, have been fully considered but they are not persuasive. Applicant states that the rejection has been obviated by the current amendments. Said claims have been amended to generally read "... wherein the level of acrylamide [or asparagine] in said food material is reduced by at least about 10% from the level in the food material in a previous condition", by adding the phrase "from the level in the food material in a previous condition."

This does not serve to overcome the rejection. Initially, it is important to note that acrylamide is not originally present in food materials such as the natural starchy foods, and thus if it never existed, it cannot be "reduced by at least about 10% from the level in the food material in a previous condition."

Secondly, regarding the reference to reducing the amount of asparagine "from the level in the food material in a previous condition," this is indefinite as it does not provide a positive and definite frame of reference by which the skilled artisan would be able to ascertain the metes and bounds of the claimed invention. It is unclear if the amended phrase refers to a single minute prior to the time it is measured, or a week, or perhaps during some growth phase of the food material. As previously stated on the record, the definition of the term "reduced" is not in question. Applicant has attempted to supplement the definition of the term "reduced" with the added phrase such that one skilled in the art might recognize and understand the metes and bounds of the claimed invention, yet the context of the claims and the term "reduced" is still not clear, in light of the specification. While the specification may be useful to clarify or support the claims, it is improper to rely upon the specification to provide the role of distinctly claiming the subject matter which the applicant regards as their invention. The essential conditions must be provided within the context of a claim, in order to establish the necessary properties and in order to understand how the term "reduced" applies in this context. A product, as it stands in its current state,

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cannot simply be “reduced”, without reference to a standard (for example, as compared to a control sample processed in the same manner but without the asparaginase addition).

Further, as an example, if a simple box contained five beans, it would be impossible to discern whether this amount was “reduced” from a previous higher number of beans, or even “increased” from a lower number, or had always possessed five beans. A simple label of “reduced” would not be sufficient to describe the box which originally had five beans, without proper context (and also would not differ from another box which always possessed five beans, nor one which originally had seven and where two were removed). The same principle applies to a final food product, including potato products, as instantly claimed. Thus similarly, if two distinct cooked potato crisps each contain 350 ppb of acrylamide, where one contained said amount from a control process and one had been processed according to the invention, given this data alone, it would be impossible for one skilled in the art to determine which one had been “reduced” from a previously higher amount, and which one was at this level from some other means.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroeder et al. (US PAT 4,272,554).

Schroeder et al. disclose “blister-inhibited potato chips”, which are “inhibited against blister formation during frying”. The chips are obtained by added a small amount of calcium, such as calcium chloride, to the potato slices prior to frying. After calcium addition and frying, “the resulting slices are ready for packaging.”

Regarding the specific amounts and percentage levels of acrylamide in the resultant products of the instant claims, this would have been an inherent result of the natural function of the added calcium and method disclosed. It is important to note that instant product/article claims are not limited in their means of production, and may be produced by any number of means, including the addition of cations such as calcium, the addition of asparaginase, or an extraction of asparagine from the food product, each effective in order to inhibit the formation of acrylamide from asparagine, absent any clear and convincing

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evidence and/or arguments to the contrary. While the reference is silent with regard to the inherent resultant effect of the calcium addition upon acrylamide formation, apart from inhibited blistering after frying, it is noted that the reference need not appreciate every aspect or property of the disclosed invention. This does not detract from the teachings of the reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

i) Claims 45-46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (US PAT 4,272,554), taken as cited above.

It would have been obvious to one of ordinary skill in the art to have packaged and appropriately labeled the potato chips produced by Schroeder et al. Packaging and labeling techniques were well-known and common in the art, especially regarding any potential special feature that might draw the interest of the consumer. Regarding the particular message, it is noted that the printed word itself would not significantly change the claimed article of matter, and would not provide a patentable distinction, *per se*, over the known prior art package materials and methods.

ii) Claims 1-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elder et al. (Pub. No. US 2004/0058054). The reference and rejection are taken as cited in a previous Office action.

In response to the rejection, applicant has provided a Suggestion for Interference, pursuant to 37 C.F.R. § 41.202. This is further addressed below. However, applicant has not submitted arguments, declarations and/or evidence to overcome the rejection at hand, and thus it remains for the reasons of record. For example, such evidence may be in the form of a properly executed declaration under 37 CFR 1.131 or 1.132.

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Double Patenting Claim Rejections

Applicant's submitted terminal disclaimers have also overcome all double patenting rejections of record.

Response to Suggestion for Interference Pursuant to 37 C.F.R. § 41.202

At this time, the Office will not comment on the status of another application which is not co-owned and related to the current application, and/or possesses a common inventor. Regardless of any potential interference which may or may not eventually occur in any given application, the applicant must overcome all applicable and appropriate rejections, i.e. 35 U.S.C. 112 and prior art rejections, before the current claims may be considered allowable and in condition for further action, be it allowance or interference.

The papers, declarations and exhibits submitted by applicant will be kept of record in this application, and in the event that such proceedings are deemed necessary, will be relied upon at that time.

Given applicant's proposed scenario and in response to applicant's comments, applicant is also referred to MPEP section 2303, which states that "an interference should rarely be suggested until examination is completed on all other issues. Each pending claim must be allowed, finally rejected, or canceled." MPEP section 2302 reads:

Practice 2. Party not in condition for allowance.

When:

- (A) a first application and a second application claim the same patentable invention;
and
 - (B) a first application is in condition for allowance; and
 - (C) the second application is not in condition for allowance,
- then generally a notice of allowance should be entered in the first application and it should become a patent.

Without suspending action in the first application and after consultation consistent with Practice 1 above, the examiner may wish to give the second applicant a very brief period of time within which to put the second application in condition for allowance, e.g., by canceling rejected claims thereby leaving only allowable claims which interfere with the claims of the first application.

When examination of the second application is complete, an application versus patent interference may be appropriate.

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Practice 3. Both in condition for allowance; earliest effective filing dates within six months.

When two applications are in condition for allowance and the earliest effective filing dates of the applications are within six months of each other, an application versus application interference may be suggested, provided the applicant with the later filing date makes the showing required by 37 CFR 41.202(d). Note that if the earliest filed application is available as a reference (for example, as a published application under 35 U.S.C. 102(e)) against the other application, then a rejection should be made against the other application. Ideally, the rejection would be made early in the prosecution, but if it is not and as a result the junior application is not in condition for allowance, then the senior application should be issued. In light of patent term adjustments it is no longer appropriate to suspend an application on the chance that an interference might ultimately result.

At the time of this Office action, the current application is not in condition for allowance, as all issues have not been resolved.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER